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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,300	07/24/2000	Paul L. Hickman	HSC1P002A	7235

7590 05/06/2004  
PERKINS COIE LLP  
101JEFFERSON DRIVE  
MENLO PARK,, CA 94025-1114

EXAMINER
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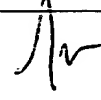
SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/625,300	Applicant(s) HICKMAN ET AL. 	
	Examiner Jonathan D. Schlaifer	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 3/12/2004.
2. The objections to the drawings are withdrawn as necessitated by amendment. New drawings were received on 3/12/2004. These drawings are acceptable.
3. This action is responsive to application 09/625,300 filed on 07/25/2000, with prior art filed on 12/2/2002, 1/9/2003, and 4/21/2003.
4. None of the claims have been cancelled.
5. Claims 1-30 are pending in the case. Claims 1, 21, and 27 are independent claims. None of the claims have been amended.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 21-22 and 27-28 remain rejected under 35 U.S.C. 102(b) as being unpatentable over Brown (USPN 5,740,361—filing date 6/3/1996)**
7. **Regarding independent claim 21**, Brown discloses in col. 3, lines 59- 67 and col. 4, lines 1-8, providing an HTML based form to a client machine coupled to a TCP/IP network (a password check box is provided to the client); at least partially automatically filling-in said form based upon input from said client machine (the user keys in the form), verifying information on said form based upon stored heuristics (since it is a password, it

must be checked against the password database) and submitting said form to a receiving agency over said network (the password must be checked over a network).

8. **Regarding dependent claim 22**, Brown discloses in col. 3, lines 62-63 that the user name is obtained at the same time as the password, constituting a method for electronically filing documents further comprising adding additional information to said form based upon input from said client machine prior to verifying said information.
9. **Regarding independent claim 27**, it is a computer readable medium with instructions for performing the method of claim 21, and may be rejected under similar rationale.
10. **Regarding independent claim 28**, it is a computer readable medium with instructions for performing the method of claim 22, and may be rejected under similar rationale.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-9 and 12-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen et al. (USPN 6,493,722 B1—filing date 4/13/1999), hereinafter Daleen further in view of Pearson (USPN 6,023,684—filing date 10/1/1997)**
12. **Regarding independent claim 1**, in col. 4, lines 7-8, Daleen states that people identify databases as electronic filing systems, and Daleen's invention encompasses a database (item 104 in Figure 1). Daleen's invention also includes a receiving agency server

coupled to a wide area network (the referring page web server, item 106 in Figure 1).

Daleen also discloses client machines coupled to a wide area network that communicates to the receiving agency server (the PC clients, item 112 in Figure 1). Daleen fails to disclose a web server coupled to a wide area network that serves as an interface to said receiving agency server. However, in Figure 2, Pearson shows the use of intermediate servers because, as implied by Pearson's discussion of the setup of the servers in col. 1-21. Pearson's discussion and the Figure indicates that one may employ a path such as a path from the client (26 or 28) to the web server (50) to the application server (56). Such a setup allows control and filtering of data flow. It would have been obvious to one of ordinary skill in the art at the time of the invention to add Pearson's intermediate web server to Daleen's invention in order to allow control and filtering of data flow.

13. **Regarding dependent claim 2**, Pearson's Figure 2 shows that Web server 50 and Application server 56 (the receiving agency server) communicate directly with each other without going through wide area network.
14. **Regarding dependent claim 3**, Dahleen, in Figure 1, shows how to combine multiple servers into one machine (the referring page web server, the billing system, and the database server) in order to integrate their functionality smoothly. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the web server and the receiving agency server on the same machine in order to integrate their functionality smoothly.
15. **Regarding dependent claim 4**, Dahleen, in Figure 1, shows the use of a third party web server (108) that is separated from the referring web page server (106). It would

communicate over the wide area network in order to allow the two servers to share information. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the servers communicate over the wide area network in order to allow the two servers to share information.

16. **Regarding dependent claim 5**, Dahleen's network is the Internet, which is a TCP/IP protocol network.
17. **Regarding dependent claim 6**, Dahleen's network is the Internet.
18. **Regarding dependent claim 7**, Dahleen fails to disclose that said web server and said client machine communicate with each other over said wide area network. However, Pearson shows that the clients (26 and 28) communicate with the Web Server (50) through the Internet (34) in Figure 2 in order to transmit information to be processed. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the client communicate with the web server over the wide area network in order to transmit information to be processed.
19. **Regarding dependent claim 8**, Pearson's network is the Internet, which is a TCP/IP protocol network.
20. **Regarding dependent claim 9**, Pearson's network is the Internet.
21. **Regarding dependent claim 12**, Daleen's invention integrates a billing system, which constitutes an automated electronic filing system wherein said web server transacts a financial transaction with said receiving agency server on behalf of said client machine.
22. **Regarding dependent claim 13**, Daleen's invention provides a message to the user (item 508 in Figure 5A) which constitutes an automated electronic filing system wherein said

web server automatically provides a portion of said electronic document in response to a selection originating from said client machine.

- 23. Claims 10-11 and 18-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson, further in view of Blackwell, Jr., et al. (USPN 5,857,191—filing date 7/8/1996), hereinafter Blackwell, Jr.**
- 24. Regarding dependent claim 10,** Daleen and Pearson fail to disclose a filing system wherein communications between said client machine and said web server are at least partially encrypted. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that encryption may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt communications between said client machine and said web server to provide added security.
- 25. Regarding dependent claim 11,** Daleen and Pearson fail to disclose a filing system wherein communications between said client machine and said web server are subject to authentication. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that authentication may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to authenticate communications between said client machine and said web server to provide added security.
- 26. Regarding dependent claim 18,** Daleen and Pearson fail to disclose a filing system wherein communications between said receiving agency server and said web server are at least partially encrypted. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that

encryption may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt communications between said client machine and said web server to provide added security.

27. **Regarding dependent claim 19**, Daleen and Pearson fail to disclose a filing system wherein communications between said receiving agency server and said web server are subject to authentication. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that authentication may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to authenticate communications between said client machine and said web server to provide added security.
28. **Claims 14-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson, further in view of Hartman, et al. (USPN 5,758,324—2/8/1996), hereinafter Hartman**
29. **Regarding dependent claim 14**, Daleen and Pearson fail to disclose an automated electronic filing system further comprising an applicant machine coupled to said wide area network. However, Hartman discloses the use of an applicant machine in item 134 of Figure 1 in order to carry out outside transactions with the server. Hartman does not disclose that the connection is via the wide area network, but since Daleen's and Pearson's inventions are both connected via a wide area network, it would have been obvious to have the connection occur via the wide area network because this would have been a convenient connection means. It would have been obvious to one of ordinary skill



in the art at the time of the invention to use an applicant machine coupled to said wide area network because it would allow outside transactions with the server and because it would have been a convenient connection means.

30. **Regarding dependent claim 15**, Daleen and Pearson and Hartman fail to disclose an automated electronic filing system wherein said applicant machine communicates with said web server over said wide area network. However, the applicant machine in the arrangement of claim 14 is connected to the overall system by the wide area network, and the wide area network is an obvious method for the communications link (item 28, Figure 1) of Hartman, in accordance with the routing communications system of Pearson, because it is a convenient and versatile communications method. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the wide area network to allow communications between the web server and the applicant machine because it is a convenient and versatile communications method.
31. **Claims 16-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson, further in view of Hartman, further in view of Blackwell, Jr.**
32. **Regarding dependent claim 16**, Daleen and Pearson and Hartman fail to disclose a filing system wherein communications between said applicant machine and said web server are at least partially encrypted. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that encryption may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt

communications between said client machine and said web server to provide added security.

33. **Regarding dependent claim 17**, Daleen and Pearson and Hartman fail to disclose a filing system wherein communications between said applicant machine and said web server are subject to authentication. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that authentication may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to authenticate communications between said client machine and said web server to provide added security.
34. **Claim 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson further in view of Lee (USPN 5,347,477—filing date 3/2/1993)**
35. **Regarding dependent claim 20**, Daleen and Pearson fail to disclose an automated electronic filing system wherein said web server provides said client machine with a form that can be at least partially automatically filled-in in response to said selection. However, Lee in the Abstract discloses the use of a Form that can be filled in as an operational metaphor in order to facilitate user access to computer functions. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a form with input capacity in order to facilitate user access to computer functions.

36. **Claims 23 and 25 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway (USPN 5,604,802—filing date 7/18/1994)**
37. **Regarding dependent claim 23**, Brown fails to disclose a method further comprising obtaining an electron signature prior to submitting said form to said receiving agency. However, Holloway, in col. 5, lines 33-55 describes the use of an electronic signature in order to increase the security of transactions. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate electronic signatures into Brown in order to increase the security of the form transactions of the invention.
38. **Regarding dependent claim 25**, Brown fails to disclose a method wherein said electronic signature is obtained from said client machine. However, in Holloway's disclose about electronic signatures in col. 5, lines 33-55, the signature is resident on smart cards, which may readily be seen to be analogous to the client machine, in that they serve as a ready point at which data is input into a network. It would have been obvious to one of ordinary skill in the art at the time of the invention to obtain the electronic signature from said client machine, because they serve as a ready means of inputting data into the network.
39. **Regarding independent claim 29**, it is a computer readable medium with instructions for performing the method of claim 23, and may be rejected under similar rationale.
40. **Claims 24 and 30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway, further in view of Wiitala et al. (USPN 6,122,622—filing date 2/18/1998)**

41. **Regarding dependent claim 24**, Brown and Holloway fail to disclose a method further comprising paying a filing fee to said receiving agency in conjunction with the submission of said form to said agency. However, Wiitala discloses that a filing fee should be submitted in conjunction with a form in order to facilitate registration. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate fees and forms into Brown and Holloway's work in order to facilitate registration.

42. **Regarding independent claim 30**, it is a computer readable medium with instructions for performing the method of claim 24, and may be rejected under similar rationale.

43. **Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway further in view of Hartman**

44. **Regarding dependent claim 26**, Brown and Holloway fail to disclose a method wherein said electron signature is obtained from an applicant machine coupled to said TCP/IP network. However, Hartman discloses the use of an applicant machine in item 134 of Figure 1 in order to carry out outside transactions with a server. Hartman does not specifically disclose that the applicant machine would be connected by the TCP/IP network, but since communication in the method occurs via the TCP/IP network, it would have been obvious to one of ordinary skill in the art at the time of the invention to use TCP/IP as the connection. It would have been obvious to one of ordinary skill in the art at the time of the invention to integrate Hartman's work into Brown and Holloway's work in order to carry out outside transactions with a server.

***Response to Amendment***

45. Applicant's arguments filed 3/12/2004 have been fully considered but they are not persuasive.
46. For Claims 21 and 27, the Applicant maintains that Brown does not teach at least partially automatically filling in an HTML based form based upon input from a client machine, verifying information on the HTML form based upon stored heuristics, or submitting the HTML form to a receiving agency over a network. The Examiner reaffirms his position maintained in the Office Action, that it is partially automatic processing of the password because it is automatically stored as it is keyed in, the password is verified based upon stored heuristics because it is compared to a password database, and the HTML form is submitted to a receiving agency notwithstanding the challenge-response technique because information about the form is transmitted.
47. For claims 1-9, Applicant maintains that Daleen's databases are insufficient to serve as electronic filing cabinets. The Examiner respectfully maintains that Daleen's databases, in combination with receiving agency servers, would be capable of performing this function. Furthermore, Applicant maintains that Pearson would not address the problem of intermediate servers. The Examiner, for the reasons set forth in the office action, holds this not to be the case.
48. The Examiner apologizes for the confusion by lines 6-7 on page 4 of the Office Action. The reference should have been to col. 3, lines 1-21 of Pearson.
49. The Examiner notes that functional interrelationships would inherently have involved some form of connection.

50. The Applicant's remarks related to claims 10-11 and 18-19 makes no substantive claim and hence the Examiner maintains his rejection as provided in the Office Action.
51. With respect to claims 14-15, the connection of the applicant machine to the wide area network would have been inherent to the combination of art, and hence the Examiner maintains his rejection as provided in the Office Action.
52. With respect to claims 16-17, no significant arguments are made to advance the traversal, and hence the Examiner maintains his rejection as provided in the Office Action.
53. With respect to claim 20, Lee teaches the automatic filling in of forms because the results of the user's input are automatically processed.
54. With respect to claims 23, 25, and 29, no significant arguments are made to advance the traversal, and hence the Examiner maintains his rejection as provided in the Office Action.
55. With respect to claims 24 and 30, Wiitala provides the limitation that a filing fee should be presented to facilitate registration, and in the context of the other references, would be automated.
56. With respect to claims 26, no significant arguments are made to advance the traversal, and hence the Examiner maintains his rejection as provided in the Office Action.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

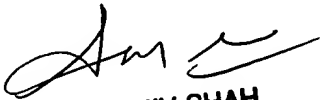
USPN 6,314,415 B1 (filing date 11/4/1998)—Mukherjee

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

  
**SANJIV SHAH  
PRIMARY EXAMINER**

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS